

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

OAKLEY, INC.,

vs.

BUGABOOS EYEWEAR CORP, and  
BUGABOOS EYEWEAR (U.S.) INC.,

Plaintiff,

Defendant.

CASE NO. 09CV2037 JLS (JMA)

**ORDER GRANTING PLAINTIFF'S  
MOTION FOR SUMMARY  
JUDGMENT ON DEFENDANT'S  
SEVENTH COUNTERCLAIM FOR  
FALSE MARKING**

(Doc. No. 27)

Defendants Bugaboos Eyewear, Corp., and Bugaboos Eyewear (U.S.) Inc., (collectively Bugaboos) allege in its counterclaim that Plaintiff Oakley, Inc. (Oakley) falsely marked its products in violation of 35 U.S.C. § 292, the patent false marking statute. In response, Oakley motions for summary judgment on the issue whether warranty cards—packaged with the eyewear sold—can give rise to a false marking claim. To make its decision, the Court considers Oakley's motion (Doc. No. 27 (Mot. Summ. J.)), Bugaboos' response in opposition (Doc. No. 59 (Opp'n)), and Oakley's reply in support. (Doc. No. 67 (Reply).) And having done so, the Court **GRANTS** Oakley's motion for summary judgment on the seventh counterclaim with respect to warranty cards. On a related note, Bugaboos requests the Court delay adjudication of Oakley's motion on two bases: first, that adjudication of Oakley's motion is improper at this time, and second, that Bugaboos requires additional discovery under Federal Rule of Civil Procedure 56(f). Both requests are **DENIED**.

## BACKGROUND

Oakley and Bugaboos are both in the eyewear business. On November 6, 2009, Oakley filed a first amended complaint against Bugaboos. (Doc. No. 7 (FAC).) Oakley asserted claims for infringement of U.S. Design Patent D580,963, U.S. Patent 5,387,949, U.S. Patent 5,638,145, Trademark 2,393,107, Trademark 2,900,432, and Trademark 2,768,242. Six months later, Bugaboos filed its answer and counterclaims. (Doc. No. 12 (Counterclaim).) Oakley answered the counterclaims soon thereafter. (Doc. No. 15.) And on August 26, 2010, Oakley filed the present motion for summary judgment on Bugaboos' seventh counterclaim.

Bugaboos' seventh counterclaim is for false marking arising under 35 U.S.C. § 292. Bugaboos contends that Oakley eyewear "are sold with a box or package directing a purchaser to examine the packaging or enclosed warranty card for a list of patents covering the enclosed product." (Counterclaim ¶ 46.) The package states "[t]his product may be protected by one or more U.S. and international patents identified on the packaging or enclosed warranty card." (*Id.*) And the "enclosed warranty card" contains a listing of United States and foreign patents. Each warranty card also states "patents pending in the USA" even though there are allegedly no patents pending. (*Id.* ¶ 62.) And finally, one version of the warranty card not only includes patents that are not owned by Oakley, but also patents that are unrelated to glasses. (*Id.* ¶¶ 75 & 76.)

Oakley understood Bugaboos' counterclaim to mean that "the list of patents on the warranty card constitutes false marking because numerous patents do not all apply to the enclosed products, some patents are expired, and other patents are erroneous numbers." (Mot. Summ. J. at 2.) And based on that understanding, Oakley brings its motion for summary judgment. Oakley argues that the warranty cards and the list of patents found on the warranty cards cannot give rise to liability under § 292 as a matter of law. (*Id.*)

In its opposition to Oakley's motion, Bugaboos also raises two new issues. First, Bugaboos argues that the motion for summary judgment should be denied because Oakley's false marking violations extend beyond the warranty cards. (Opp'n at 22–23.) Second, Bugaboos argues that Oakley's motion is premature and additional time should be granted for Bugaboos to obtain additional discovery. (Opp'n at 23.)

Thus, this Order discusses two topics. The Court will first discuss Oakley's motion for summary judgment. As part of this discussion, the Court will resolve the issue whether Oakley's motion for summary judgment should be denied in light of other potential bases for false marking liability. The second portion of the Order will discuss whether Bugaboos' request for additional discovery under Rule 56(f).

## OAKLEY'S MOTION FOR SUMMARY JUDGMENT

### 1. Legal Standard

Federal Rule of Civil Procedure 56 permits a court to grant summary judgment where (1) the moving party demonstrates the absence of a genuine issue of material fact and (2) entitlement to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). "Material," for purposes of Rule 56, means that the fact, under governing substantive law, could affect the outcome of the case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Freeman v. Arpaio*, 125 F.3d 732, 735 (9th Cir. 1997). For a dispute to be "genuine," a reasonable jury must be able to return a verdict for the nonmoving party. *Anderson*, 477 U.S. at 248.

The initial burden of establishing the absence of a genuine issue of material fact falls on the moving party. *Celotex*, 477 U.S. at 323. The movant can carry his burden in two ways: (1) by presenting evidence that negates an essential element of the nonmoving party's case; or (2) by demonstrating that the nonmoving party "failed to make a sufficient showing on an essential element of her case with respect to which she has the burden of proof." *Id.* at 322–23. "Disputes over irrelevant or unnecessary facts will not preclude a grant of summary judgment." *T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir. 1987).

Once the moving party establishes the absence of genuine issues of material fact, the burden shifts to the nonmoving party to set forth facts showing that a genuine issue of disputed fact remains. *Celotex*, 477 U.S. at 324. The nonmoving party cannot oppose a properly supported summary judgment motion by "rest[ing] on mere allegations or denials of his pleadings." *Anderson*, 477 U.S. at 256. When ruling on a summary judgment motion, the court must view all inferences drawn from the underlying facts in the light most favorable to the nonmoving party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986).

1     **2.     Analysis**

2           Before getting into the nitty-gritty, it helps to visualize the items at issue. When a  
3 consumer purchases a pair of Oakley eyewear, the consumer receives a box.<sup>1</sup> After opening it, the  
4 purchaser discovers—among other things—a pair of eyewear and a warranty card.

5           Bugaboos’ false marking counterclaim is brought under 35 U.S.C. § 292. Section 292  
6 states in relevant part:

7           Whoever marks upon, or affixes to, or uses in advertising in connection with any  
8 unpatented article, the word “patent” or any word or number importing that the  
9 same is patented for the purpose of deceiving the public . . . [s]hall be fined not  
10 more than \$500 for every such offense.

11 35 U.S.C. § 292. When broken down, the statute has four important parts: (1) the word “patent” or  
12 any word or number importing that an article is patented, (2) marked on, affixed to, or used in  
13 advertising in connection with, (3) an unpatented article, (4) with intent to deceive the public. *See*  
14 *Clontech Labs., Inc. v. Invitrogen Corp.*, 263 F. Supp. 2d, 780, 791 (D. Del. 2003).

15           From the statutory morass, a roadmap is revealed. A plaintiff must first find some instance  
16 of “the word ‘patent’ or any word or number conveying that an article is patented.” 35 U.S.C.  
17 § 292. For the purposes of discussion, the Court refers to this as the “patent coverage language” or  
18 “coverage language.” The Court uses this instead of “marking,” because “marking” in the patent  
19 context conjures 35 U.S.C. § 287, the notice statute. And involving § 287 in the fray has only  
20 served to confuse the matter.

21           Once the patent coverage language has been established, the analysis moves to elements  
22 two and three. The plaintiff must show that the coverage language is “marked upon” an  
23 unpatented article, “affixed to” an unpatented article, or “used in advertising in connection with”  
24 an unpatented article. If any of the three occur, the plaintiff must finally establish element four,  
25 that the action was done with “intent to deceive the public.” 35 U.S.C. § 292.

26           Oakley moves for summary judgement on the issue whether the warranty card found inside  
27 the packaging can give rise to false marking liability. On summary judgment, Oakley bears the

28           

---

          <sup>1</sup>The box is often referred to as “packaging.”

1 initial burden of showing that the warranty cards do not satisfy § 292's requirements. If Oakley  
2 succeeds, the burden is on Bugaboos to show that an issue of material fact remains.

3 **A. *Element One: Patent Coverage Language***

4 The Court begins its analysis with the first element of the statute. In doing so, the Court  
5 not only determines the scope of Oakley's motion for summary judgment, but also lays the  
6 groundwork for the Order. On the surface, the question seems straightforward: Bugaboos need  
7 only identify the "the word 'patent' or any word or number conveying that an article is patented."  
8 35 U.S.C. § 292. But this has been a source of confusion between the parties. And the discussion  
9 has meandered down paths that needn't be traveled.

10 For the purposes of this Order the patent coverage language is the warranty cards and the  
11 patents printed on them. Bugaboos' counterclaim focuses entirely on the warranty cards. (*See*  
12 Counterclaim ¶¶ 39–87.) And Oakley's motion for summary judgment responded in kind. Oakley  
13 understood Bugaboos' counterclaim as alleging that "the warranty card constitutes false marking."  
14 (Mot. Summ. J. at 2.) It was not until Bugaboos' opposition to Oakley's motion did Bugaboos  
15 raise the possibility of false marking based on something other than warranty cards. (Opp'n at  
16 22–23 (discussing barcodes as potential basis for false marking).) But just because Bugaboos may  
17 have found a new source of false marking liability does not widen what is at issue in this motion.  
18 Oakley requested summary judgment only on the issue of warranty cards, and that is what the  
19 Court will adjudicate.

20 For clarity's sake, the Court notes what is not at issue in this motion, and that is two things.  
21 The barcodes on the boxes are not at issue here. (*See* Opp'n at 22–23.) And more importantly the  
22 phrase that is printed on the exterior of the box—"this product may be protected by one or more  
23 U.S. and international patents identified on the packaging or enclosed warranty card"—is not at  
24 issue either. Bugaboos relies on this language to argue that the warranty cards are subject to § 292  
25 liability. (Opp'n at 12.) But Bugaboos does not argue that the language itself is liable.

26 This latter point is important in light of *Pequignot v. Solo Cup Co.*, 608 F.3d 1356 (Fed.  
27 Cir. 2010). The parties spill considerable ink discussing the merits and applicability of *Pequignot*,  
28 but the discussion is not useful. There were two instances of coverage language at issue in

1 *Pequignot*. The first was two patents molded onto the product. *Id.* at 1358–59. The second was  
2 language printed on the packaging: “This product may be covered by one or more U.S. or foreign  
3 pending or issued patents. For details contact [www.solocup.com](http://www.solocup.com).” *Id.* at 1359. The *Pequignot*  
4 court indicated that Solo Cup could not be liable for false marking arising from the “may be  
5 covered” language because Solo Cup did not have the requisite intent. *Id.* at 1365.

6 The important distinction between this case and *Pequignot* is that *Pequignot* discussed the  
7 “may be covered” language on the packaging. *Id.* Here, the coverage language at issue is not the  
8 “may be protected” language on Oakley’s box: it is Oakley’s warranty cards. Any discussion of  
9 *Pequignot* on this matter is irrelevant. If *Pequignot* had discussed whether the contents of the  
10 website found at [www.solocup.com](http://www.solocup.com) could be subject to false marking liability, the Court might  
11 find the case useful. But it didn’t, so the Court doesn’t.

12 The narrow focus of the motion for summary judgment raises another issue. Bugaboos  
13 argues that Oakley’s motion is not appropriately adjudicated at this time if it focuses on the  
14 warranty cards only. Bugaboos argued in oral argument that Federal Rule of Civil Procedure 56  
15 does not allow for the partial adjudication of a claim. The Court disagrees. *See Zapata Hermanos*  
16 *Sucesores, S.A. v. Hearthside Baking Co.*, 313 F.3d 385, 391 (7th Cir. 2002). The Court finds it  
17 appropriate to determine whether Bugaboos can assert a false marking claim based on the warranty  
18 cards. Resolving this issue clarifies and narrows Bugaboos’ false marking claim for trial. If there  
19 are other bases for § 292 liability, those bases can be resolved another day.

20 At this point, the Court has determined that the entity satisfying the “the word ‘patent’ or  
21 any word or number conveying that an article is patented” portion of the false marking statute is  
22 the warranty card. And with that, the Court moves to the next two elements.

23 ***B. Elements Two and Three***

24 These elements—particularly element two—constitute the main dispute. Whether the  
25 warranty cards satisfy these elements determines whether Oakley has met its burden on summary  
26 judgment. And after considering the matter, the Court finds that no issue of material fact remains.  
27 The warranty cards cannot be subject to § 292 liability as a matter of law.

28 Elements two and three of the statute are: “(2) marked on, affixed to, or used in

1 advertisement in connection with, (3) an unpatented article.” “Unpatented article” has been  
2 defined in the § 292 context, but the Court will not reproduce that definition here. Instead, the  
3 Court will assume that every pair of Oakley eyewear constitutes a § 292 unpatented article. This  
4 limits the question to whether the warranty cards are “marked on, affixed to, or used in advertising  
5 in connection with” the co-packaged eyewear. The Court discusses each in turn.

6 (1) *Marked On*

7 Here, the issue is whether warranty cards and the list of patents printed on the warranty  
8 cards can be subject to the false marking statute by virtue of being “marked on” an unpatented  
9 article, the Oakley eyewear. The operative phrase is “marked upon.”

10 It is undisputed that the neither the warranty card nor the contents of the warranty card are  
11 marked upon the eyewear. This is not fatal to Bugaboos’ false marking claim, however, because it  
12 is possible for markings on the packaging of an item to be subject to the false marking statute. *See*  
13 *Pequignot*, 608 F.3d at 1365. But again the problem is that neither the warranty card nor its  
14 contents are printed on the packaging—they are found inside.

15 Bugaboos argues that the warranty cards are incorporated onto the packaging because  
16 printed on the packaging is the statement “this product may be protected by one or more U.S. and  
17 international patents identified on the packaging or enclosed warranty card.” (*See Opp’n* at 12.)  
18 But Bugaboos provides no authority for the argument that incorporation is sufficient to meet the  
19 “marks upon” requirement. And the Court finds the notion contrary to the plain meaning of the  
20 language.

21 On this issue, the parties expend considerable ink discussing the finer points of patent  
22 law—none of which the Court finds relevant. For instance, the parties contest whether a marking  
23 must provide constructive notice under 35 U.S.C. § 287 before it can be subject to false marking  
24 liability. That discussion sheds no light on whether the warranty cards in question are “marked  
25 upon” anything. The Court can find no authority that patent coverage language must be marked in  
26 a way that satisfies § 287 before it is “marked upon” for the purposes of the false marking statute.

27 Bugaboos does raise one case that could provide support for the proposition that a coverage  
28 found inside packaging can satisfy the “marked upon” portion of the statute. The district court in



1 *Clontech*, held a bench trial concerning, among other things, false marking of Invitrogen's  
2 products. One finding of fact was that Invitrogen had marked "the product profile sheets" of its  
3 products. *Clontech*, 263 F. Supp. 2d at 788. The product profile sheets were, at least according to  
4 Bugaboos, placed "inside product packages." (Opp'n at 15.) The court later held that Invitrogen  
5 had falsely marked its products but that it did not have the requisite intent for liability under § 292.  
6 *Clontech*, 263 F. Supp. 2d at 793. Based on these facts, Bugaboos contends that packaging inserts  
7 can be "false marking within the statute." (Opp'n at 15.)

8 A closer reading of *Clontech* proves the issue less clear cut. The district court found that  
9 Invitrogen "marked the product profile sheets of SS, SSII, kits including SSII, and cDNA  
10 libraries." *Clontech*, 263 F. Supp. 2d at 788. And the remainder of the decision uses the word  
11 "products" when indicating that items were wrongly marked. The *Clontech* court never explicitly  
12 stated that the product profile sheets were subject to the false marking statute.

13 In fact, the issue of wrongful marking was a non-issue; Invitrogen conceded the point. The  
14 *Clontech* court never discussed out what constituted the patent coverage language. It didn't need  
15 to because plenty of items clearly satisfied that requirement. Instead, "the gravamen of plaintiff's  
16 false marking claim [was] whether or not defendant marked its products 'with intent to deceive the  
17 public.'" *Id.* at 792. Given the facts of the case, this Court will not infer from *Clontech* that items  
18 found inside the packaging satisfy the "marks upon" language of the false marking statute.

19 The Court finds, as a matter of law, that the warranty cards and the patents listed on them  
20 cannot be subject to the false marking statute under the "marks upon" language. The warranty  
21 cards are not marked upon the glasses or the packaging. The statutory language seems clear, and  
22 the Court applies it accordingly.

23 (2) *Affixed To*

24 As noted before, each box contains a warranty card and a pair of eyewear. The issue here  
25 is whether the warranty cards are affixed to the eyewear in a manner subjecting the warranty cards  
26 to false marking liability. Bugaboos provides that "a common definition of the word 'affix' is to  
27 'attach in any way.'" (Opp'n at 17.) And Bugaboos argues that the warranty card is attached to  
28 "each Oakley eyewear product by virtue of the way in which they are tightly packaged with each



product.” (*Id.*) But this argument fails as a matter of law: one pea in a pod is not affixed to the other. While the warranty card and the eyewear are tightly packaged together, doing so does not render one affixed to the other.

(3) *Used in Advertising in Connection With*

The final issue is whether the warranty cards are “used in advertising in connection with” the eyewear, and thus subject to false marking liability.

The first step is to determine whether “advertising” has a “plain and unambiguous meaning with regard to the particular dispute in the case.” *Robinson v. Shell Oil Co.*, 519 U.S. 337 (1997). “Advertising” is defined as “the action of calling something to the attention of the public especially by paid announcements.” *Advertising*, Merriam-Webster.com, <http://www.merriam-webster.com> (last visited November 10, 2010).

“Case law interpreting a similar term under the Lanham Act provides further guidance.” *Inventorprise, Inc. v. Target Corp.*, 2009 WL 3644076 (N.D.N.Y. Nov. 2, 2009). The Lanham Act provides, in relevant part, that “to constitute commercial advertising or promotion, a statement of fact must be: . . . (3) for the purpose of influencing consumers to buy defendant’s goods or services. While the representations need not be made in a ‘classic advertising campaign,’ but may consist instead of more informal types of ‘promotion,’ the representations (4) must be disseminated sufficiently to the relevant purchasing public to constitute ‘advertising’ or ‘promotion’ within that industry.” *Newcal Indus., Inc. v. Ikon Office Solution*, 513 F.3d 1038, 1054 (quoting *Coastal Abstract Serv., Inc. v. First Am. Title Ins. Co.*, 173 F.3d 725, 735 (9th Cir.1999)).

But this definition is actually too broad for our purposes. For where the Lanham Act concerns both “advertising” and “promotion,” the patent false marking statute concerns only “advertising.” See *Chamilia, LLC v. Pandora Jewelry, LLC*, 2007 WL 2781246 (S.D.N.Y. Sept. 24, 2007) (internal quotations omitted). Thus, the false marking statute captures a narrower scope of activities than the Lanham Act.

Given the plain meaning of “advertising” and the body of law interpreting “advertising” in the Lanham context, the Court finds that Oakley’s warranty cards are not “advertising” subject to false marking liability. Oakley’s warranty cards are found inside the packaging; they are invisible

1 until the product is purchased and the packaging opened. And in that regard, they are not used to  
2 call something to the attention of the public by way of paid announcement. *Advertising*, Merriam-  
3 Webster.com, <http://www.merriam-webster.com>. It would be impossible for them to call attention  
4 to the eyewear before the eyewear is purchased.

5 The Lanham Act provides additional support. The Court finds no situation in which the  
6 warranty cards, contained inside the packaging, could influence customers to buy Oakley's  
7 eyewear. *See Newcal Indus.*, 513 F.3d at 1054. And because the warranty cards are accessible  
8 only after the product is sold, the warranty cards are not disseminated to the "relevant purchasing  
9 public." *See id.* Thus, to the extent the Lanham Act is relevant, it supports the finding that the  
10 warranty cards are not "advertising" subject to false marking penalties.

11 Many courts have cited to *Accent Designs, Inc. v. Jan Jewelry Designs, Inc.*, 827 F. Supp.  
12 957 (S.D.N.Y. July 12, 1993), for the proposition that "'uses in advertising' cannot refer to any and  
13 all documents by which the word 'patent' is brought to the attention of the public; it can only refer  
14 to use of the word 'patent' in publications which are designed to promote the allegedly unpatented  
15 product, namely, advertisements." *Accent Designs*, 827 F. Supp. at 968–69. The language  
16 supports this Court's position. But in citing to it, the Court notes that the *Accent Designs* court  
17 ultimately rejected that line of reasoning as being too narrow in the context of that case. Under the  
18 facts of this case, however, the Court finds the reasoning applicable and convincing.

19 Bugaboos attempts to create an issue of material fact regarding the warranty cards status as  
20 "advertisement" by entering the declaration of an expert witness. (Opp'n, Nunes Decl.) But the  
21 expert's testimony is irrelevant under the circumstances because, as noted above, statutory  
22 interpretation falls under the purview of the Court. And having interpreted the meaning of  
23 "advertising" as a matter of law, the expert's testimony provides little to the discussion.

24 At oral argument, Bugaboos argued that the warranty cards also constitute advertising  
25 sufficient for § 292 liability because they are handed out to customers and given away separate  
26 from eyewear. And thus, the warranty cards are used in advertising independent from their  
27 inclusion in the product packaging. But to find that this action satisfies § 292 would ignore a  
28 portion of the statute.

1           Section § 292 states that the coverage language must be “use[d] in advertising in  
2 connection with any unpatented article.” 35 U.S.C. § 292. If the Court accepted Bugaboos’  
3 argument that distributing warranty cards separate from eyewear constitutes advertising sufficient  
4 to satisfy § 292, the Court would have to ignore the “in connection with” language. Even if  
5 Bugaboos’ allegations were true, there would not be a connection between the coverage language  
6 and an unpatented product in that situation. No connection exists when the warranty  
7 cards—which do not reference specific products—are separated from products. Consumers would  
8 not know what products the warranty cards referred to.

9           After construing “advertising” as it is found in the false marking statute, the Court finds  
10 that Oakley’s warranty cards are not subject to false marking liability on that grounds that they are  
11 “use[d] in advertising in connection with any unpatented article.” 35 U.S.C. § 292. Considering  
12 the plain meaning of “advertising” and its construction in the Lanham context, the warranty cards  
13 and their use do not constitute advertising.

### 14       **3. Conclusion**

15           Having determined that the warranty cards are the patent coverage language at issue, the  
16 Court then considered whether the warranty cards could satisfy elements two and three of § 292.  
17 This portion of the analysis formed the core of Oakley’s motion summary judgment: simply that  
18 the warranty cards could not be subject to the false marking statute because the warranty cards are  
19 not “marked upon,” “affixed to,” or “used in advertising in connection with” an unpatented article.  
20 To simplify the analysis, the Court assumed, without deciding, that all Oakley eyewear was  
21 unpatented for § 292 purposes. And on the issue whether the warranty cards are “marked upon,”  
22 “affixed to,” or “used in advertising in connection with,” the Court finds that the warranty cards do  
23 none of those things.

24           First, the warranty cards and their contents are not marked upon the eyewear or upon the  
25 outer packaging. Thus, Bugaboos’ counterclaim fails as a matter of law as to this portion of the  
26 statute. The Court finds unpersuasive the argument that the warranty cards are incorporated onto  
27 the outer packaging. The Court also finds unpersuasive the argument that something found inside  
28 the packaging can be subject to the false marking statute. Second, the warranty cards cannot be

1 affixed to the glasses by virtue of close proximity. Bugaboos counterclaim fails as a matter of law  
 2 as to this portion of the statute. And finally, the warranty cards are not advertising as a matter of  
 3 law. The plain meaning of “advertising” and its construction under the Lanham Act forecloses the  
 4 possibility that warranty cards found inside packaging and available to consumers only after  
 5 purchase can be considered advertising.

6 No issues of material fact remain. Oakley’s motion for summary judgment on the issue  
 7 whether the warranty cards can be subject to § 292 liability is **GRANTED**. The warranty cards  
 8 are not subject to § 292 liability.

### 9 **BUGABOOS’ RULE 56(f) MOTION**

10 Bugaboos argues that it “has been unfairly prejudiced by Oakley’s premature summary  
 11 judgment motion and requests additional discovery responses so that it can fully expose Oakley’s  
 12 false marking practices.” (Opp’n at 23.)

13 Rule 56(f) allows the Court to deny or continue a motion for summary judgement if the  
 14 opposing party needs time to discover essential facts. *Garrett v. City and Cnty. of San Francisco*,  
 15 818 F.2d 1515, 1518 (9th Cir. 1987). To obtain a Rule 56(f) continuance, a party must show: “(1)  
 16 that they have set forth in affidavit form the specific facts that they hope to elicit from further  
 17 discovery, (2) that the facts sought exist, and (3) that these sought-after facts are ‘essential’ to  
 18 resist the summary judgment motion.” *Cal. ex rel. Cal. Dep’t of Toxic Substances Control v.*  
 19 *Campbell*, 138 F.3d 772, 779 (9th Cir.1998). If the moving party can make this showing, rule 56(f)  
 20 “requir[es], rather than merely permit[s],” an opportunity for additional discovery. *Metabolife*  
 21 *Int’l, Inc. v. Wornick*, 264 F.3d 832, 846 (9th Cir.2001) (quoting *Anderson v. Liberty Lobby, Inc.*,  
 22 477 U.S. 242, 250 n.5 (1986)).

23 Bugaboos argues that “Oakley has still not produced all versions of the warranty cards that  
 24 are the subject of its motion and has still not produced all samples of its products, product  
 25 packaging and marking for eyewear products.” (Opp’n, LaPorte Decl. ¶ 12.) The Court finds that  
 26 these sought-after-facts are not essential to resist Oakley’s motion for summary judgment.

27 Obtaining all versions of the warranty cards would not overcome the fact that the warranty  
 28 cards are not subject to the false marking statute as a matter of law. Bugaboos’ attempts to subject

1 the warranty cards to false marking liability fail for reasons that cannot be remedied by additional  
2 facts. For instance, Bugaboos argues that the warranty cards are “marked upon” the packaging  
3 because of a turn-of-phrase found on the packaging. The Court rejects this theory. Reviewing  
4 additional warranty cards would not solve Bugaboos’ shortcomings.

5 Bugaboos also requests discovery on additional “products, product packaging and marking  
6 for eyewear products.” (*Id.*) These requests are unrelated to the motion at hand, which concerns  
7 the warranty cards only.

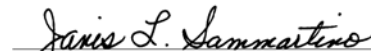
8 Bugaboos requests the Court to continue or deny Oakley’s motion for summary judgment  
9 pending further discovery. But the Court finds that the additional discovery Bugaboos requests is  
10 orthogonal to the motion being considered. Thus, Bugaboos Rule 56(f) motion is **DENIED**.

#### 11 **CONCLUSION**

12 In response to Bugaboos’ counterclaim for false marking under 35 U.S.C. § 292, Oakley  
13 motioned for summary judgment on the issue whether its warranty cards could be subject to false  
14 marking liability. For the reasons stated above, the Court **GRANTS** Oakley’s motion for  
15 summary judgment. Oakley’s warranty cards are not subject to 35 U.S.C. § 292 liability.  
16 Moreover, the Court **DENIES** Bugaboos’ requests to deny Oakley’s motion as untimely and for  
17 additional discovery under Rule 56(f).

18 **IT IS SO ORDERED.**

19  
20 DATED: December 15, 2010

21   
22 Honorable Janis L. Sammartino  
23 United States District Judge  
24  
25  
26  
27  
28